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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/829,019	04/20/2004	Jamy Gannoe	514362000910	5977
7590 Fulwider Patton LLP Howard Hughes center 6060 Center Drive, Tenth Floor Los Angeles, CA 90045				
03/19/2009				
EXAMINER				
EREZO, DARWIN P				
ART UNIT		PAPER NUMBER		
3773				
MAIL DATE		DELIVERY MODE		
03/19/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/829,019

**Applicant(s)**

GANNOE ET AL.

**Examiner**

Darwin P. Erezzo

**Art Unit**

3773

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 and 26-29 is/are pending in the application.
- 4a) Of the above claim(s) 16 and 27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-15, 17-19, 26, 28 and 29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 December 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. This Office action is in response to the applicant's communication filed on 12/22/08

***Drawings***

2. The drawings were received on 12/22/08. These drawings are acceptable.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-12, 17-19, 26 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,542,949 to Yoon.

Yoon discloses a device comprising: an elongate main body 42 having a proximal end, a distal end, and a length therebetween; a first jaw member 46 and a second jaw member 48 each pivotally connected to the distal end of the main body, wherein the first and the second jaw members are adapted to move from a first configuration to a second expanded configuration in which the jaw members are translationally positioned into apposition with each other (via cams 120 and 122; col. 6, ll. 17), and wherein the first and the second jaw members each define an opening 86, 88 capable of acquiring a portion of a tissue within the opening, wherein the openings are in fluid communication with lumens defined in the main body (see Fig. 3); wherein the main body defines additional lumens (one for supplying staples 40 and one for the

jaw members); wherein the device comprises a pull/push rod 89 for articulating the jaw members; wherein the device has a handle with ports and lever (Fig. 1); wherein the first and second jaw members are connected to the main body via crescent shaped hinges (Fig. 5; where jaw members 46 and 48 connect to inner cylinder 89) that are oriented 180 deg. from each other (flipped over); wherein the openings are at 180 degrees apart (see Fig. 3; the jaw members are mirror images and are oriented 180 deg. apart); wherein each of the openings extend into the jaw member along the longitudinal axis of the jaw member (including 0-5 cm. to 1 inch); wherein the device comprises a fastening assembly comprising staples 40; which assists in tissue healing, wherein the openings are a fenestration (opening in a surface).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoon, as applied to the rejections above., and in further view of US 5,810,846 to Virnich et al.

Yoon discloses all the limitations of the claims except for the device having guide rod/wire. However, the use of a guide rod/wire in a stapler device is well known in the art, as shown in Fig. 3a of Virnich, element 104. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Yoon to include a guide rod/wire as it will allow a practitioner to guide the device into the surgical site.

9. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yoon, as applied to the rejections above.

Yoon discloses all the limitations of the claims except for the opening comprising a plurality of fenestrations. However, Marucci discloses that it known in the tissue grasping art to have a plurality of openings/perforations/fenestrations along the surface

of the jaw member to be utilized as a additional means of grasping tissue via suction (page 10, lines 25-36). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Yoon to have the plurality of openings along the jaw members because it would provide an additional means of grasping the tissue.

### ***Response to Arguments***

10. Applicant's arguments regarding US 5,954,731 to Yoon have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of US 5,542,949 to Yoon.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Darwin P. Erez whose telephone number is (571)272-4695. The examiner can normally be reached on M-F (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on (571) 272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Darwin P. Erezol/  
Primary Examiner, Art Unit 3773